



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/083,278 05/22/98 FUJIWARA

Y 041-2013

022429
LOWE HAUPTMAN GOPSTEIN
GILMAN AND BERNER LLP
SUITE 310
1700 DIAGONAL ROAD
ALEXANDRIA VA 22314

TM02/0727

EXAMINER

ZIMMERMAN, B

ART UNIT

PAPER NUMBER

2635

DATE MAILED:

07/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/083,278

Applicant(s)

FUJIWARA ET AL.

Examiner

Brian A Zimmerman

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 2635

Status of Application.

In response to the applicant's amendment received on 5/21/01. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-17 are unpatentable for the reasons set forth in this office action:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

1. Claims 1,2,4-6,11,12,17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the WO publication to Motorola (WO 96/06417, hereafter referred to as Motorola).

Motorola shows a pager, which receives codes. A first portion of the codes is compared to a stored address to **detect** if the message is directed to the particular paging receiver, page 4 lines 20+. A second portion of the codes is used to display information to the user (page 4 lines 34+), and a third portion of the codes is used to activate a sound generator to audibly generate recalled tones (of chromatic scale) to be heard by the user for presenting an audible composition to the user (page 4 lines 35+).

2. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kahn (5777997).

Art Unit: 2635

Kahn shows a radio receiver which receives a digital signal with codes. The receiver displays information based upon receipt of some of the codes, and generates audio information based upon receipt of some of the codes as claimed.

Claim Rejections - 35 USC § 103

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the WO publication to Motorola in view of Wong (5394140).

Motorola, as discussed above in conjunction with claims 1,4,11; shows pager for displaying and audibly generating tones for each message. Motorola does not expressly show an input means on the pager for assigning tonal compositions to be played in response to specific composition codes. In an analogous art, Wong shows a pager, which generates audible messages in response to received message codes. See abstract. This permits the user to have some creative control over how the audible composition is presented. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an input means on the pager in order to permit the user to creatively control the audible output of an composition discussed in the Motorola document.

4. Claims 3,7,13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motorola and Wong as applied to claims 1,4,11,14 above, and further in view of Fisch (4873520).

Art Unit: 2635

In an analogous art, Fisch shows voice message pager. The pager of Fisch uses voice as the audible composition, in order to convey addition information to the user upon retrieval or playing of the message. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used voice as the audible composition in the above discusses system in order to convey additional information regarding the message.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Motorola publication as applied to claim 4 above, and further in view of Kawashima (5332994).

In an analogous art, Kawashima shows audible message pager. The pager of Kawashima uses the audible composition to convey addition information to the user. Kawashima uses a timer 12 to limit the time interval which the selected tone is generated, this provides protection to the power supply in that the audible generator does not drain the battery. It is also noted that stop commands are verily common in POCSAG systems. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a timer to limit the audible composition in the above discusses system in order to prevent excessive battery drain.

Response to Arguments

Applicant's arguments filed 5/21/01 have been fully considered but they are not persuasive.

Art Unit: 2635

The applicant argues that an ordinary pager emits a single tone to tell the user that a message has been received. The messages are displayed on the image screen of the pager. The tone that is broadcast does not convey information or entertainment or anything else. The applicant then argues that the instant receiver is adapted to emit an alert signal but uses received codes to transmit audio information or entertainment, which the applicant argues is not shown by the references.

First it is noted that the use of the term **adapted** in claims 1,4,14, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Additionally, it is noted that the applicant appears to be discussing an "ordinary pager." Although, the definition of an ordinary pager is not clear, it appears that the applicant believes all devices other than theirs are to be considered "ordinary pagers." It is suggested that the applicant be more explicit in discussing the prior art rejection and associated references. Therefore, it remains the examiner's position that the Motorola publication shows the claim limitations of claims 1,2,4,6,11,12 (and now claim 17).

Assuming the applicant is arguing that the Motorola publication, applied in the Office Action, does not include a tone that is broadcast to convey information or entertainment. The examiner notes that the claims do not include any limitation such that the tone broadcast is intended to convey information or entertainment.

Art Unit: 2635

Regarding claim 14, the applicant argues that the Wong reference does not show a registration means within the receiver that is adapted to store a relationship between the demodulated data and sound combinations and patterns that include tones to form a melody.

Wong is not cited for teaching digital data combinations forming tones that are used to form a melody. Not only does Wong teach such a feature, see discussion above. Such would be inherent in the digital tone composition of the Motorola Publication, see page 2 lines 32+.

Regarding claims 3,7,13 and 16, the applicant argues that Fisch does not show a coded signal that activates stored tones in the form of a melody or the like. Not only does Fisch show such a feature, see rejection above; also, the Motorola publication uses received codes to form a melody by audibly producing tones corresponding to the received codes. See page 2 lines 32+.

Regarding claims 8-10, the applicant argues that Kawashima does not use a timer to maintain the length of a tone before moving on to the next tone. Such a limitation is not expressly set forth in the claims, however this limitation is inherent in the Motorola Publication in that the playing of a melody/composition using received codes must maintain the length of a tone for a time period before moving on to the next tone.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 703-305-4796. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.


Brian A Zimmerman
Primary Examiner
Art Unit 2635

BaZ
July 26, 2001